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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,435	07/03/2003	Norihiro Edwin Aoki	AOL0118	5118
22862	7590	06/27/2007		
GLENN PATENT GROUP 3475 EDISON WAY, SUITE L MENLO PARK, CA 94025			EXAMINER WON, MICHAEL YOUNG	
			ART UNIT 2155	PAPER NUMBER
			MAIL DATE 06/27/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/613,435

Applicant(s)

AOKI ET AL.

Examiner

Michael Y. Won

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

MICHAEL WON
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 5/18/07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to the amendment filed April 19, 2007.
2. Claims 1-10 have been cancelled and new claims 11-22 have been added.
3. Claims 11-22 have been examined and are pending with this action.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 21 and 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The language of claims 21 and 22 raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

The applicant(s) claim "Computer-readable media" but does not define within the body of the claim the hardware in which the invention runs. Thus, absent recitation of the server or some other hardware, claims 21 and 22 are not limited to a tangible embodiment, instead being sufficiently broad to encompass software, per se.

The examiner encourages applicant to define within the claims the embodied features and limitations on a "storage" computer readable medium such as hard drives, disks, and other hardware elements. An example of a proper format would be "A computer-readable storage medium...".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 11-17 and 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Maltby et al. (US 6,202,100 B1).

INDEPENDENT:

As per **claim 11**, Maltby teaches a method of communications between first and second computers having an open instant messaging (IM) connection (see Fig.2), the first and second computers running respective IM application programs providing an IM window at each computer for displaying an exchange of text messages (see col.6, lines 33-36 and col.7, lines 10-13: "appropriate communications software ("COMMS") at each terminal to provide data communications between terminal A and terminal B"), the method comprising operations of:

the IM application programs cooperatively replicating contents and format of a clipboard provided by an operating system running at the first computer in a clipboard

provided by an operating system running at the second computer (see col.6, lines 12-15 & lines 36-38 and col.7, lines 49-50: "The contents of CLIPBOARD A are thus reproduced on CLIPBOARD B").

As per **claim 20**, Maltby teaches a process of communications between first and second computers having an open text messaging link (see Fig.2), the computers running respective text messaging application programs providing a text messaging window at each computer for displaying an exchange of text messages (see col.6, lines 33-36: "both the first and second computers run conferencing application, which are responsible for exchanging messages between the first and second computers" and col.7, lines 10-13), the process comprising operations of:

replicating contents and format of a first computer's operating system clipboard in an operating system clipboard of a second computer, where the replicating operation is conducted responsive to coordinated user instructions submitted via respective text messaging application programs of the first and second computers (see col.6, lines 12-15 & lines 36-38 and col.7, lines 49-50: "The contents of CLIPBOARD A are thus reproduced on CLIPBOARD B").

As per **claim 21**, Maltby teaches a computer-readable media containing a first program for installing a second program, the second program when installed on multiple target computers performing operations for communications between first and second computers having an open instant messaging (IM) connection (see Fig.2), the first and second computers running respective IM application programs providing an IM window at each computer for displaying an exchange of text messages (see col.6, lines 33-36

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and col.7, lines 10-13: "appropriate communications software ("COMMS") at each terminal to provide data communications between terminal A and terminal B"), the operations comprising:

the IM application programs cooperatively replicating contents and format of a clipboard provided by an operating system running at the first computer in a clipboard provided by an operating system running at the second computer (see col.6, lines 12-15 & lines 36-38 and col.7, lines 49-50: "The contents of CLIPBOARD A are thus reproduced on CLIPBOARD B").

As per **claim 22**, Maltby teaches a computer-readable media containing a first program for installing a second program, the second program when installed on multiple target computers performing operations for communications between first and second computers having an open IM link (see Fig.2), the computers running respective IM application programs providing an IM window at each computer for displaying an exchange of text messages (see col.6, lines 33-36 and col.7, lines 10-13: "appropriate communications software ("COMMS") at each terminal to provide data communications between terminal A and terminal B"), the operations comprising:

replicating contents and format of a first computer's operating system clipboard in an operating system clipboard of a second computer, where the replicating operation is conducted responsive to coordinated user instructions submitted at each of the computers via interfaces provided by windows of respective IM application programs (see col.6, lines 12-15 & lines 36-38 and col.7, lines 49-50: "The contents of CLIPBOARD A are thus reproduced on CLIPBOARD B").

DEPENDENT:

As per **claim 12**, which depends on claim 11, Maltby further teaches where the replicating, operations comprise:

responsive to the first computer receiving a predetermined user input sequence including invocation of a predetermined paste command of the operating system running at the first computer, where the predetermined user input sequence is performed in conjunction with the IM window at the first computer, the IM application program running on the first computer performing operations including uploading contents and format of the clipboard of the operating system running at the first computer (see col.1, lines 51-58);

responsive to the IM application program running on the first computer receiving user entry of a send command, the IM application program running on the first computer transferring said uploaded contents and format to the second computer (see col.7, lines 32-45);

responsive to receiving the transferred contents and format, the IM application program running on the second computer presenting a user prompt in conjunction with the IM window of the second computer (see col.7, lines 66-67 and col.8, lines 3-7, 9-11; & 40-43);

the IM application program running on the second computer, responsive to user selection of the user prompt, copying the transferred contents and format to the clipboard of the operating system running at the second computer (see col.8, lines 9-29).

As per **claim 13**, which depends on claim 11, Maltby further teaches where the replicating operations comprise:

responsive to the first computer receiving a predetermined user input sequence including invocation of a predetermined paste command of the operating system running at the first computer, where the user input sequence is performed in conjunction with the IM window at the first computer (see col.1, lines 51-58), the IM program running on the first computer presenting an acknowledgement message in conjunction with the IM window of the first computer (see col.7, lines 41-43 & 57-59);

responsive to the IM application program running on the first computer receiving user entry of a send command, performing operations comprising:

the IM application program running on the first computer uploading contents and format of the clipboard of the operating system running at the first computer, and transferring said uploaded contents and format to the second computer (see col.7, lines 32-45);

the IM application program running on the second computer presenting a user prompt in conjunction with the IM window of the second computer (see col.7, lines 66-67 and col.8, lines 3-7, 9-11, & 40-43);

the IM application program running on the second computer, responsive to receiving user selection of the user prompt, copying the transferred contents and format to the clipboard of operating system running at the second computer (see col.8, lines 9-29).

As per **claim 14**, which depends on claim 11, Maltby further teaches where the transmitting and replicating operations comprise:

responsive to the IM application program running on the first computer receiving user entry of a send command, performing operations comprising:

the IM application program running on the first computer sending notice of the paste to the IM application program running on the second computer (see col.7, lines 32-45);

the IM application program running on the second computer presenting a user prompt in conjunction with the IM window of the second computer (see col.7, lines 66-67 and col.8, lines 3-7, 9-11, & 40-43);

responsive to receiving user selection of the user prompt, performing operations comprising:

the IM application program running on the first computer uploading contents and format of the clipboard of the operating system running at the first computer, and transferring said uploaded contents and format to the second computer (see col.8, lines 9-29);

the IM application program running on the second computer copying the transferred contents and format to the clipboard of the operating system running at the second computer (see col.8, lines 25-29).

As per **claim 15**, which depends on claim 11, Maltby further teaches where the replicating operation comprises responsive to the first computer receiving a predetermined user input sequence including invocation of a predetermined paste

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command of the operating system running at the first computer, where the predetermined user input sequence is performed in conjunction with the IM window at the first computer (see col.1, lines 51-58), the IM application program running on the first computer performing at least one of:

- uploading contents and format of the clipboard of the operating system running at the first computer (see col.7, lines 54-57);

- uploading contents and format of the clipboard of the operating system running at the first computer and transferring the uploaded contents and format to the second computer (see col.7, lines 61-67 & col.8, lines);

- sending notice of the paste to the IM application program running on the second computer (see col.4, lines 41-44).

As per **claim 16**, which depends on claim 11, Maltby further where: the operations further comprise, before completion of said replicating operation, the IM program at the second computer presenting a user prompt in conjunction with the IM window of the second computer (see col.7, lines 66-67 and col.8, lines 3-7, 9-11, & 40-43);

- completion of the replicating operation is conditioned on the IM application program running on the second computer receiving user selection of the user prompt (see col.8, lines 9-29).

As per **claim 18**, which depends on claim 16, Maltby further teaches that the clipboard of the operating system running at the first computer having been populated

by a document fragment from a given source application program (see col.1, lines 51-54);

the user prompt further including identification of the given source application program (see col.8, lines 40-43).

As per **claim 19**, which depends on claim 16, Maltby further teaches that the clipboard of the operating system running at the first computer having been populated by differently formatted versions of a document fragment from a source application program (see col.1, lines 34-35);

the replicating operation placing the differently formatted versions of the document fragment into the clipboard of the operating system of the second computer (see col.1, lines 27-31), reserving choice as between the versions to any application programs running on the second computer receiving a predetermined user input sequence including invocation of a predetermined paste command of the operating system running at the second computer (see col.1, lines 35-37).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maltby et al. (US 6,202,100 B1) in view of Standridge et al. (US 2003/0221009 A1).

As per **claim 17**, which depends on claim 16, Maltby does not explicitly teach that the user prompt comprising a hyperlink.

Standridge teach of a user prompt comprising a hyperlink (see page 2, [0016]: "URL appearing in its IM chat box").

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Maltby in view of Standridge by implementing a user prompt comprising a hyperlink. One would be motivated to do so because hyperlink is a user-friendly means (click or select) of referencing or navigating to the data and automatically bringing the data to the user. Maltby teaches of linking to retrieve a copy of the data from the server (see col.2, lines 22-29).

Response to Arguments

7. Applicant presented no arguments with respect to new claims 11-22. New reference Maltby et al. (US 6,202,100 B1) has been cited to explicitly teach the limitations of claims 11-17 and 19-22 as anticipated under 35 U.S.C. 102(b) and new reference Standridge et al. (US 2003/0221009 A1) has been cited to teach the missing limitation of claim 17 under 35 U.S.C. 103(a) (see rejections above).

For the reasons above claims 11-22 have been rejected and remain pending.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

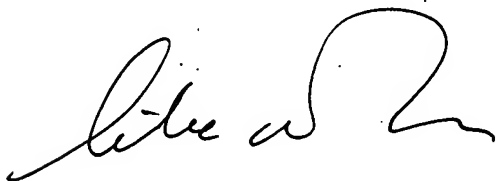
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Y. Won whose telephone number is 571-272-3993. The examiner can normally be reached on M-Th: 7AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Michael Won', with a stylized, flowing script.

MICHAEL WON
PRIMARY EXAMINER

June 12, 2007